

rejection, the Examiner correctly identified that the pending claims of the present application are not identical to the claims of the cited references, but the Examiner concluded that the claims are not patentably distinct from each other because the pending density range limitation completely overlaps the density limitations in the identified claims of the cited references.

Applicant has studied the identified claims of the cited references in view of the pending claims, and Applicant respectfully traverses and requests withdrawal of the provisional obviousness-type double patenting rejections for any of the following reasons, any one of which should be sufficient to compel withdrawal of the rejections: (1) the provisional obviousness-type double patenting rejections violate MPEP Section 804(1)(B), and (2) the pending claims and identified claims recite patentably distinguishable subject matter.

1. The Provisional Obviousness-type Double Patenting Rejections Violate MPEP § 804(1)(B) and Should Therefore Be Withdrawn

The only issues raised in the third Office action are the above-discussed provisional obviousness-type double patenting rejections. Section 804(1)(B) of the MPEP specifically requires that in such a situation, where the provisional obviousness-type double patenting rejections are the sole rejections, the rejection should be withdrawn. Portions of Section 804(1)(B) of the MPEP are reproduced below for the Examiner's convenience, with the Examiner's attention being directed to the second paragraph.

804 Definition of Double Patenting

1. Instances Where Double Patenting Can Be Raised

B. Between Copending Applications-Provisional Rejections

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a “provisional” rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The “provisional” double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that “provisional” double patenting rejection is the only rejection remaining in one of the applications. If the “provisional” double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the “provisional” double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the “provisional” double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a “provisional” double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Because the previously issued formal rejections of the claims have all been overcome and the only remaining issues are provisional obviousness-type double patenting rejections, Applicant submits that the rejections should be withdrawn. As indicated above in the cited portion of the MPEP, the rejections may be reconsidered in the cited references after the present application issues as a patent. However, in the case at hand, the rejection should be withdrawn to permit the present application to issue as patent.

2. The Pending Claims and Identified Claims Recite Patentably Distinguishable Subject Matter

Each of the provisional obviousness-type double patenting rejections is apparently made because the pending claims recite a density range that overlaps the density range recited in the claims of the cited references. Applicant respectfully traverses these grounds for the rejections, as the subject matter of the pending claims is both novel and non-obvious, with the pending claims reciting subject matter that is neither recited nor suggested in the identified claims. Specifically, the pending claims include two independent claims, namely, claims 1 and 38. The independent claims are reproduced below for the Examiner's convenience.

1. A firearms cartridge, comprising:
a casing;
a primer;
a propellant; and
at least one projectile having a density of at least 10 g/cc, wherein the projectile is formed by compressing a powder-form composition of matter that includes a tungsten-containing powder and a binder that includes a metallic binder

component and a non-metallic binder component, wherein the metallic binder component includes at least 50 wt% tin, and further wherein the non-metallic binder component includes at least one of a thermoset resin or epoxy and comprises 0.25 to 3 wt% of the powder-form composition of matter.

38. A method for manufacturing a medium-density article, the method comprising:

- mixing a tungsten-containing powder with a binder powder to form a powder-form composition of matter, wherein the binder powder includes a metallic binder component and a non-metallic binder component, and further wherein the metallic binder component forms at least 10 wt% of the powder-form composition of matter and the non-metallic binder component forms 0.25 to 3 wt% of the powder-form composition of matter and includes at least one of a thermoset resin or epoxy;

- placing the powder-form composition of matter into a die; and

- compressing the powder-form composition of matter to produce an article having a density of at least 8 g/cc.

As should be evident by reviewing the above claims, each claim recites, amongst other subject matter, an article formed from a powder-based composition of matter that includes a tungsten-containing powder, a metallic binder component, and a non-metallic binder component, with the non-metallic binder component comprising 0.25 to 3 wt% of the powder-form composition of matter and including at least one thermoset resin or epoxy. Applicant submits that none of the cited references contain claims that recite this subject matter or otherwise justify the proposed obviousness-type double patenting rejections. Accordingly, Applicant requests that the rejections be withdrawn. For the purpose of completeness, each of the cited pending applications is briefly discussed below.

(A) U.S. Patent Application Serial No. 10/011,148

U.S. Patent Application Serial No. 10/011,148 is no longer pending. Accordingly, Applicant submits that the provisional obviousness-type double patenting rejection based on the '148 application is now moot.

(B) U.S. Patent Application Serial No. 10/698,827

U.S. Patent Application Serial No. 10/698,827 is presently pending with claims 1-50, of which claims 1, 31 and 40 are independent claims. Independent claims 1 and 31 are method claims that are directed to methods for infiltrating sealant beneath the outer surface of an article formed via powder metallurgy. Claim 40 is directed to a firearms cartridge that includes a projectile having an outer surface and a central interior region, with the projectile further including a sealant extending beneath the outer surface but not distributed throughout the central interior region. In the third Office action, the pending claims of the present application were rejected on the grounds that they recite a density range that completely overlaps the density ranges claimed in the '827 application.

Applicant respectfully requests reconsideration and withdrawal of the provisional obviousness-type double patenting rejection because the pending claims in the '827 application do not recite any density range limitations. Furthermore, the pending claims in the '827 application do not recite a firearms projectile that includes, amongst other subject matter, both a metallic binder component and a non-metallic binder component that includes at least one thermoset resin or epoxy. Instead, the pending claims in the '827 application recite methods for infiltrating sealant into an article and/or sealed

articles having sealant beneath their outer surfaces but not distributed throughout their interior regions. Accordingly, Applicant submits that the pending and cited claims recite patentably distinct subject matter and that the provisional obviousness-type double patenting rejection should be withdrawn.

(C) U.S. Patent Application Serial No. 10/821,392

U.S. Patent Application Serial No. 10/821,392 contains 39 pending claims, of which claims 1, 14, 23, 28, 33, and 39 are independent claims. In the third Office action, the pending claims of the present application were rejected on the grounds that they recite a density range that completely overlaps the density ranges claimed in the '392 application. However, only some of the claims of the '392 application recite a density range at all. Perhaps more importantly, the pending claims of the '392 application are all directed to methods of separating ferrotungsten-containing powder into magnetic and non-magnetic fractions, and to articles formed therefrom. Furthermore, none of the pending claims recite a firearms projectile that includes a metallic binder and a non-metallic binder that includes at least one thermoset resin or epoxy. Accordingly, Applicant submits that the pending and cited claims recite patentably distinct subject matter and that the provisional obviousness-type double patenting rejection should be withdrawn.

(D) U.S. Patent Application Serial No. 10/900,531

U.S. Patent Application Serial No. 10/900,531 claims priority to the present application and contains 28 pending claims. However, none of these claims recite a

firearms projectile that includes a metallic binder and a non-metallic binder that includes at least one thermoset resin or epoxy. Accordingly, Applicant submits that the pending and cited claims recite patentably distinct subject matter and that the provisional obviousness-type double patenting rejection should be withdrawn.

For at least the above reasons, Applicant traverses and requests withdrawal of the provisional obviousness-type double patenting rejections and allowance of all pending claims. Applicant submits that all of the issues raised in the third Office action have been addressed and overcome. If there are any remaining issues or if the Examiner has any questions, Applicant's undersigned attorney may be reached at the number listed below. Similarly, if the Examiner believes that a telephone interview may be productive in advancing prosecution of the present application, the Examiner is invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'David S. D'Ascenzo', is written over a horizontal line.

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